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PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number (Optional)
H-203315 (8540R-000001)

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

Application Number
10/601,269Filed
June 20, 2003First Named Inventor
Kia et al.

On _____

Art Unit
1774Examiner
Merrick L. Dixon

Signature _____

Typed or printed name Anna M. Budde

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 35,085.

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Anna M Budde
Signature

Anna M. Budde
Typed or printed name

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Telephone number

May 11, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/601,269
Filing Date: June 20, 2003
Applicants: Kia et al.
Group Art Unit: 1774
Examiner: Merrick L. Dixon
Title: BARRIER COAT FOR OPEN TOOL MOLDING
Attorney Docket: H-203315 (8540R-000001)

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

STATEMENT ACCOMPANYING THE PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Final Rejection mailed December 30, 2005, Applicants have filed a Notice of Appeal and a Request for Pre-Appeal Brief Review. This Statement accompanies Applicants' Request.

With a two-month extension of time, reply is timely on or before May 30, 2006. Applicants hereby petition for a two-month extension of the period of response and attach a grantable petition under 37 C.F.R. § 1.136.

REMARKS

Claims 1 to 43 are now pending in the application. Claims 1 to 10 and 20 to 27 are allowed and Claims 11 to 19 and 28 to 43 stand rejected. An Amendment After Final filed on February 28, 2006 was not entered.

DOUBLE PATENTING (SAME INVENTION TYPE) IN VIEW OF CO-PENDING APPLICATION 10/601,250

The Examiner clearly erred in provisionally rejecting Claims 11, 15, 20, 28 to 32, and 43 under 35 U.S.C. § 101. The present claims and the claims of the co-pending application do not recite identical subject matter. The present claims could be literally infringed without literal infringement of the claims of the co-pending application, and vice versa.

Applicants address this point in the Amendment After Final at pages 11 to 14. A table is presented therein showing that embodiments that fall within the claims of the co-pending application would not infringe the claims of the present application, and vice versa. For instance, Applicants point out that present Claim 11 is drawn to an automotive body panel and would not infringe the independent method Claim 1 of the co-pending application. Amendment After Final at page 14. Additionally, Applicants demonstrate that many of the present claims recite fibers that are ≤ 1 mm in length, a limitation not recited in any of the co-pending claims. Id. Thus, Applicants' claims and the claims of the co-pending application are of different scope.

The rejected claims do not claim the same invention as that of the co-pending application. Accordingly, Applicant respectfully request the rejection be withdrawn.

DOUBLE PATENTING (SAME INVENTION TYPE) IN VIEW OF CO-PENDING APPLICATION 10/623,922

The Examiner clearly erred in provisionally rejecting Claims 11, 42, and 43 under 35 U.S.C. § 101. The present claims and the claims of the co-pending application do not recite identical subject matter or claim the same invention.

To demonstrate this point, Applicants again draw attention to a table comparing the rejected claims on the left to the claims of the co-pending application on the right. Amendment After Final at pages 15-16. For example, the co-pending application claims recite that the gel coat forms a surface body panel that maintains 60% or more of its gloss. Id. An embodiment that doesn't maintain 60% gloss after UV exposure but has reinforcing fibers of the recited length would infringe present Claim 1, but not Claim 18 of the co-pending application. Id. Therefore, the present claims can be literally infringed without literal infringement of the claims of the co-pending application, and vice versa.

Because the rejected claims do not recite the same invention as the claims of the co-pending application, Applicants request the rejection be withdrawn.

OBVIOUSNESS TYPE DOUBLE PATENTING

Claims 35 and 40 stand rejected for obvious type double patenting over co-pending applications 10/601,250 and 10/623,922, respectively. Although Applicants deny that the claims are obvious in light of the co-pending applications, Applicants have filed Terminal Disclaimers with respect to the two applications. Applicants respectfully request entry of the Terminal Disclaimers and withdrawal of the rejection.

REJECTION UNDER 35 U.S.C. § 102

The Examiner clearly erred in rejecting method Claims 28 to 34 as anticipated by the Okayama reference because the reference does not describe the layer compositions applied to form Applicants' composite article. In particular, Claim 28 recites applying a laminate formula of a particular composition over the barrier coat. The cited reference does not disclose applying a laminate formula having the recited composition. Thus, the reference does not disclose every limitation of the claims.

Additionally, the citation of Ex parte Pfeiffer is inapplicable in this case. The claims of Pfeiffer were drawn to a method for using an article, whereas the current claims are drawn to a method for preparing a composite article. The materials on which a process is carried out must be accorded weight in determining the patentability of a process. Ex parte Leonard, 187 USPQ 122 (Bd. App. 1974). The method recites structural limitations that are necessarily "manipulatively distinct," i.e. the claimed process steps include applying novel compositions. Accordingly, the rejection under § 102(b) should be withdrawn.

In further support of Applicants' position that Claims 28 to 34 are not anticipated, the Panel is respectfully referred to the Amendment filed on October 5, 2005 at pages 12 to 13 and the Amendment After Final at pages 17 to 18.

REJECTION UNDER 35 U.S.C. § 103

The Examiner clearly erred in rejecting Claims 35 to 43 under 35 U.S.C. § 103(a). For reasons discussed above, the Okayama reference is deficient and does not anticipate the subject matter of the claims. The cited GB reference does not provide the elements missing from the Okayama reference. Accordingly, it would not have been

obvious to modify the reference and reach the recited claims. See *a/so* Amendment at pages 14-15 and Amendment After Final at pages 18-19.

For these reasons, Applicants respectfully request that the Rejection under § 103 of Claims 35 to 43 be withdrawn.

CONCLUSION

For the reasons discussed above, Applicants believe that the rejected Claims 11 to 19 and 28 to 43 are patentable. Together with the noted allowability of Claims 1 to 10 and 20 to 27, Applicants respectfully submit that all of the pending claims are in an allowable state. Accordingly, Applicants respectfully request reopening of prosecution in the case and allowance of the claims. The Panel is invited to contact Applicants' representative, if that would be helpful in resolving any issue.

Respectfully submitted,

Dated: May 11, 2006

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